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**Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER
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ART UNIT	PAPER NUMBER
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DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.

09/491 910

Applicant(s)

PIPER TODD E

Examiner

Ashwin Mehta

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED.
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may be subject to earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or f:
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 18) ☐ Interview Summary (PTO 413) Paper No(s) \_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO 162)
- 20) ☐ Other

KATRINA TURNER  
PATENT ANALYST

### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Status Of The Application***

1. Examination of this application has been transferred to Examiner Ashwin Mehta. The art unit, 1638, remains the same.

#### ***Claim Rejections***

2. Claims 1-9, 10 (amended), 11-13, 14 (amended), 15-17, 18 (amended), 19-22, 23 (amended), 24-26, 27 (amended), 28-30, 31 (amended), and 32 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, for the reasons of record stated in the last office action on pages 2-4 under item 2. See item 7 below.

3. Claims 1-9, 10 (amended), 11-13, 14 (amended), 15-17, 18 (amended), 19-22, 23 (amended), 24-26, 27 (amended), 28-30, 31 (amended), and 32 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention, for the reasons of record stated in the last office action on pages 4-5 under item 3. See item 8 below.

4. Claims 11, 15, 19, 24, 28, and 32 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for the reasons of record stated in the last office action on pages 6-7 under item 5. See item 9 below.

5. Claims 11, 15, 19, 24, 28, and 32 remain rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Carrigan, for the reasons of record stated in the last office action on pages 7-8 under item 6. See item 10 below.

***Response to Arguments***

6. Applicant's arguments filed 02 July 2001 have been fully considered but they are not persuasive.

***35 USC § 112***

7. Applicants traverse the rejection to claims 1-9, 10 (amended), 11-13, 14 (amended), 15-17, 18 (amended), 19-22, 23 (amended), 24-26, 27 (amended), 28-30, 31 (amended), and 32 under 35 U.S.C. 112, first paragraph. Applicants indicate that the actual ATCC deposit will be delayed until receipt of notice that the application is otherwise allowable. Applicant's intent is acknowledged. As the application is not in condition for allowance, the rejection is maintained.

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8. Applicants traverse the rejection to claims 1-9, 10 (amended), 11-13, 14 (amended), 15-17, 18 (amended), 19-22, 23 (amended), 24-26, 27 (amended), 28-30, 31 (amended), and 32 under 35 U.S.C. 112, second paragraph. Applicants submit that a deposit will be delayed until notice of otherwise allowable claims as provided under 37 C.F.R. 1.809. Applicants indicate that the claims will be amended at that time to recite the accession number. As the application is not in condition for allowance, the rejection is maintained.

9. Applicants traverse the rejection to 11, 15, 19, 24, 28, and 32 under 35 U.S.C. 112, second paragraph. Applicants argue that the claims recite two requirements- that 38J54 be an ancestor of the plant and second that the claimed plant be "capable of expressing a combination of at least two 38J54 traits" selected from a Markush group. Applicants argue that the presence of "38J54" in front of "traits" indicates that the Markush listing is directed to "38J54 traits" originating from 38J54, and not just "traits". However, none of the listed traits is unique to 38J54. That is, other plants possess these traits. It is therefore possible that the traits listed in the Markush group may have been introduced from other plants in the claimed plant's ancestry, and not from 38J54. Further, as discussed in the last office action, the claims have no limitation on the degree of relatedness to the derived plant, and the claims encompass plants that are vastly different from the plant taught in the specification. The rejection is maintained.

***35 USC § 102 & 103***

10. Applicants traverse the rejection to claims 11, 15, 19, 24, 28, and 32 under 35 U.S.C. 102(b) as anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious over Carrigan.

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Applicants submit that the claims do not simply recite traits, but instead recite specific traits only to the extent that they are "38J54" traits. Applicants argue that the claims also recite that the plant must have 38J54 as an ancestor, and contend that the traits therefore originated from 38J54. However, the traits listed in the claims are not unique to 38J54. Other plants may possess any one or more than one of these traits. The claims do not indicate what feature of any one of these traits makes it unique only to 38J54. Further, the claims do not distinguish plants that possess at least two of the listed traits that do not have 38J54 in its ancestry from those that do. Applicants argue that one can easily tell by reference to the plant's breeding history or its molecular profile whether the plant did indeed have 38J54 as an ancestor and expressed at least two 38J54 traits. However, the process of making the claimed plants does not distinguish the plants themselves from those taught by the reference, particularly since neither the number of other parents nor the number of generations involved in producing the plants are specified, wherein 38J54-derived genetic material is lost as the number of other parents or generations increases. See In re Thorpe, 227 USPQ 964,966 (Fed. Cir. 1985), which teaches that a product-by-process claim may be properly rejected over prior art teaching the same product produced by a different process, if the process of making the product fails to distinguish the two products. Thus, the claimed invention was clearly prima facie obvious as a whole to one of ordinary skill in the art, if not anticipated by Carrigan. The rejection is maintained.

### ***SUMMARY***

11. Claims 1-10, 12-14, 16-18, 20-23, 25-27, and 29-31 are deemed free of the prior art, given the failure of the prior art to teach or reasonably suggest hybrid maize seed 38J54 or maize

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seed or plants derived therefrom which express all of the physiological and morphological characteristics of hybrid maize plant 38J54; or tissue culture of regenerable cells of 38J54, that regenerates plants expressing all of the physiological and morphological characteristics of hybrid maize plant 38J54; or hybrid maize plant 38J54 transformed with one or more transgenes.

12. No claim is allowed.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

#### ***CONTACT INFORMATION***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashwin Mehta whose telephone number is 703-306-4540. The examiner can normally be reached on Mondays-Thursdays and alternate Fridays from 8:00 A.M.

Application/Control Number: 09/491,910

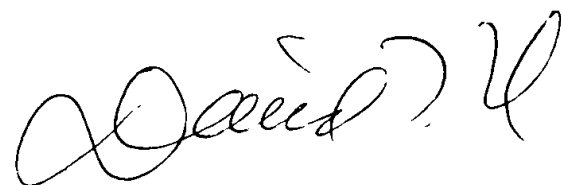
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to 5:30 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell can be reached at 703-308-4310. The fax phone numbers for the organization where this application or proceeding is assigned is 703-305-3014 or 703-872-9306 for regular communications and 703-872-9307 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Ashwin Mehta  
September 13, 2001

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP 180-1638

A handwritten signature in cursive script, appearing to read "David T. Fox", followed by a large, stylized flourish or checkmark.